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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,559	03/04/2005	Edwin Nun	266369US0PCT	9365
22850	7590	02/23/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MAZUMDAR, SONYA	
			ART UNIT	PAPER NUMBER
			1734	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/23/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/23/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/526,559

Applicant(s)

NUN ET AL.

Examiner

Sonya Mazumdar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 1-4, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/05, 2/21/06, 3/28/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1 through 11 and 14 through 17, in the reply filed on January 4, 2007 is acknowledged. The traversal is on the ground(s) that there are no adequate reasons or example provided to support a conclusion of patentable distinctness between the claimed process and product. This is not found persuasive because product-by-process claims are not limited to the manipulations of the recited process steps, but only the structure implied by the process steps.

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly

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added, but is instead produced in-situ does not change the end product.) (see

MPEP § 2113)

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 1, 2, 3, 4, 10, and 11 objected to because of the following informalities: the phrase “transfer medium” should be changed to “transfer-medium sheet” to make appropriate reference. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 through 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is only support for particles, not one particle as now encompassed by “one or more”.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 through 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. By use of the term "nanostructured" in claim 1, it is unclear whether this refers to the size of the particles or the size of the structure on the particles.

8. In claim 1, it is unclear if the particles are removed with the transfer medium or if the particles are disposed on the coating after removal of the transfer medium, resulting in a coated textile.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1 through 6, 8, 9, 10, and 14 through 17 are rejected under 35 U.S.C. 103(a) as being unpatentable by Groitzsch et al. (US 5,158,636) in view of Suzuki et al. (JP 54-114577)

With respect to claims 1, 6, and 10, Groitzsch et al. teach a method of preparing a microporous film. A hydrophilic coating (2) is spread onto a release paper (5) and a textile support (9) is laminated on top of the coating. After heating the laminate, the release paper is removed and wound into a roll (13) (abstract; column 8, lines 20-28; column 9, lines 17-22).

Groitzsch et al. do not specifically teach use of hydrophobic particles as a release agent, however Suzuki et al. teach adding a mineral powder, such as calcium carbonate which inherently is poorly soluble in water, on a release sheet (abstract). It would have been obvious for Groitzsch et al. to do so to improve a matted effect and prevent creasing.

With respect to claims 2 and 3, Groitzsch et al. teach using a release paper as a transfer medium (column 7, lines 11-13).

With respect to claims 4 and 5, Groitzsch et al. in view of Suzuki et al. teach mineral powder particles with a diameter in the range of 0.3-20 μm (abstract).

With respect to claim 8, Groitzsch et al. teach a coating to have hydrophilic properties (column 8, lines 20-28).

With respect to claim 9, Groitzsch et al. teach a coating comprising polyurethane (column 1, lines 17-22; column 12, lines 30-34).

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With respect to claims 14 through 17, Groitzsch et al. teach use of the coated microporous film as rainwear and protective covers and clothing in the medical industry (column 1, lines 23-28; column 8, lines 20-27). As a further note, claim 16 was not specifically treated, as claim 14 does not require production of a technical textile.

11. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Groitzsch et al. in view of Suzuki et al. as applied to claim 1 above, and further in view of Toyoda et al. (US 6,245,188)

The teachings of claim 1 are as described.

Groitzsch et al. in view of Suzuki et al. do not specifically teach particles on the surface of a release paper to have hydrophobic properties after performing treatment. However, Toyoda et al. teach that it would have been obvious to perform a hydrophobic surface treatment process with a compound such as hexamethyl disilazane to decrease surface energy of and enhance removal of the release paper (column 5, lines 27-38).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Groitzsch et al. in view of Suzuki et al. as applied to claim 1 above, and further in view of Van Paesschen et al. (US 3,650,740)

The teachings of claim 1 are as described.

Groitzsch et al. in view of Suzuki et al. do not teach transferring a hydrophobic layer onto a coated textile. However, Van Paesschen et al. teach that it would have been obvious to transfer hydrophobic particles onto a coating to provide a water-repellant barrier on top of a textile (abstract).

Conclusion

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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